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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/903,717

Applicant(s)

ONSHAGE ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "general authorization" is not clearly defined.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1, 2, 4, 6-8, 10, 11, 13-15, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Donovan et al (US-PAT-NO: 6,434,143).

For claims 1, 8 and 14, regarding sending from said first telecommunications device to said second telecommunications device a message requesting authorization for the recording, Donovan teaches on ABSTRACT “sending a Session Initiation Protocol (SIP) SIP INVITE request to the IMS indication a message deposit action”. The “a Session Initiation Protocol (SIP) SIP INVITE request” of Donovan is the claimed “a message requesting authorization”. The “message deposit action” of Donovan is the claimed “recording”. Regarding performing said recording only if a responding message giving said authorization is received and recognized by said first telecommunications device in response to said requesting message, Donovan teaches on ABSTRACT “receiving a corresponding SIP message from the IMS agreeing to participate in the message deposit action; and sending an SIP acknowledge message to the IMS confirming receipt of the corresponding SIP message; and depositing the message in a destination mailbox. The “depositing the message in a destination mailbox” of Donovan is the claimed “performing said recording”. The “corresponding SIP message from the IMS agreeing to” of Donovan reads on the claimed “responding message giving said authorization”.

Regarding claim 2, it is inherent that when the corresponding SIP message from the IMS of Donovan’s system either does not agree to or is not received by the first telecommunications device the recording must be prohibited.

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Regarding claim 4, Donovan teaches on item 215 Fig. 2. It is inherent that the called party must respond an “off-hook” signal when answers the call. The “off-hook” signal is the claimed “message giving authorization” (for line connection). It is also inherent that sending said responding message is under control of a user of the called party (the claimed user of the second telecommunications device).

Regarding claim 5, Donovan teaches on item 215 Fig. 2. It is inherent that the “off-hook” signal (the claimed responding message) is automatically generated by the telephone set (the claimed second telecommunications device) when the called party picks up the handset.

Regarding claims 6, 10 and 15, Donovan teaches on column 6 line 27 “the message, being of video or voice content, is then deposited into the called party’s mailbox address”. It is inherent that the user of said first telecommunications device (item 13a of Fig. 1 of Donovan) must be advised of the authorization so that the user can start depositing (recording) the message.

Regarding claim 7, Donovan teaches on column 3 line 64 the INVITE request asks the called party to join a particular conference or establish a two-way conversation. It is inherent that authorizations must be received from additional telecommunication devices for a conference.

Regarding claims 11 and 16, the applicant’s Specifications discloses on line 34 page 5 “a national telephone network in a country not requesting an authorization procedure to send a signal to a recording device”. It is inherent that the device (item 13a Fig. 1) of Donovan in U.S.

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is not required to send an authorization request. It is inherent that the device of Donovan must have received and stored a general authorization for the recording.

Regarding claim 13, Donovan teaches on item 225 Fig. 2 "IMS sends OK signal to NS". It is inherent that the "OK signal" (after receiving the authorization request; item 211 Fig. 2) is sent automatically. It is also inherent that the "sending of OK signal" is programmed on the NS.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan as applied to claim 1 above, and in view of Ishikawa et al (US-PAT-NO: 5,289,532). Donovan failed to teach sending said requesting message as a voice message. However, Ishikawa et al teaches on ABSTRACT "a voice request". The "voice request" of Ishikawa et al reads on the claimed "requesting message as a voice message". It would have been obvious to one skilled at the time the invention was made to modify Donovan to have sending said requesting message as

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a voice message as taught by Ishikawa et al such that the modified system of Donovan would be able to support the voice message request to the system users.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan as applied to claim 8 above, and in view of Raissyan et al (US-PAT-NO: 5,703,935). Donovan failed to teach speech recognition means to detect whether the responding message in response to said requesting message, in case the responding message is a voice message, gives said authorization. However, Raissyan et al teach on column 11 line 28 for detecting the called part's response, a DTMF detector and/or a voice recognition device are activated. The "voice recognition device" of Raissyan et al is the claimed "speech recognition means". It would have been obvious to one skilled at the time the invention was made to modify Donovan to have speech recognition means to detect whether the responding message in response to said requesting message, in case the responding message is a voice message, gives said authorization as taught by Raissyan et al such that the modified system of Donovan would be able to support the speech recognition means to the system users.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan as applied to claim 8 above, and in view of Ohsuge (US-PAT-NO: 6,351,635). Donovan failed to teach the device is a mobile telephone. However, Ohsuge teaches on ABSTRACT "voice recording function for a mobile telephone". It would have been obvious to one skilled at the time the invention was made to modify Donovan to have the device is a mobile telephone as taught by

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Ohsuge such that the modified system of Donovan would be able to support the mobile telephone to the system users.

***Conclusion***

6. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Lee (US-PAT-NO: 5,604,791) teaches single line telephone answering system with access security features.

7. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**



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Patent Examiner

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Ming Chow



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